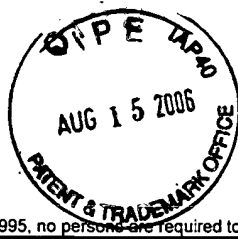


Doc Code: AP.PRE.REQ



PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

18528.451 / 249/124

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

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Typed or printed name _____

Application Number

09/756,690

Filed

Jan. 9, 2001

First Named Inventor

Orville G. KOLTERMAN

Art Unit

1646

Examiner

Dong JIANG

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒ attorney or agent of record. **41,408**
Registration number _____☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Signature

David R. Marsh

Typed or printed name

(202) 942-5000

Telephone number

August 15, 2006

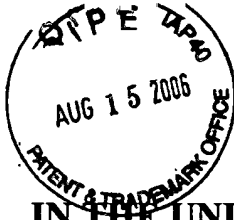
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Orville G. KOLTERMAN *et al.*

Appl. No.: 09/756,690

Filed: January 9, 2001

Confirmation no.: 4666

Art Unit: 1646

Examiner: Dong JIANG

Atty. Docket: 18528.451 / 249/124

For: **Use of Exendins and Agonists Thereof for Modulation of Triglyceride Levels and Treatment of Dyslipidemia**

Pre-Appeal Brief Request for Review

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attn: Mail Stop AF

Sir:

In response to the Office Action mailed July 26, 2006, (hereinafter "Office Action"), Applicants submit the following.

Status

Claims 1-15, 24-37, and 41 are pending. All the claims are rejected as obvious under 35 U.S.C. § 103(a) as allegedly being unpatentable over Karpe *et al.* (*Metabolism*, 48:301-07 (1999)) (hereafter "Karpe *et al.*"), in view of Beeley *et al.* (WO 98/30231) (hereafter "Beeley *et al.*") and Beers *et al.* (*The Merck Manual*, 17th ed., pages 200 and 2550 (1999)) (hereafter "Beers *et al.*") for reasons of record. Claims 15 and 37 remain rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Karpe *et al.*, Beeley *et al.*, and Beers *et al.*, further in view of Wagle *et al.* (U.S. Patent No. 6,326,396) (hereafter "Wagle *et al.*").¹

¹ For ease, Applicants have solely addressed the deficiency of the Examiner's rejection of claims 1-15, 24-37, and 41 in the body of the text. Nothing in Wagle *et al.* overcomes the deficiency of the other cited references. As such, both 35 U.S.C. § 103(a) rejections are addressed and overcome.

The Examiner Erred in Combining an Alleged Inherent Teaching in a Reference to Render an Obviousness Rejection.

Claim 1 recites a “method for lowering triglycerides in a subject in need thereof ... identifying a subject having elevated postprandial triglyceride levels; and administering ... a therapeutically effective amount of an exendin ... wherein said subjects postprandial triglyceride levels are lower.”

The essence of the Examiner’s sole rejection of claims 1-15, 24-37 and 41 is that the combination of Karpe *et al.*, and an alleged inherent teaching of Beeley *et al.* and Beers *et al.* renders the claims obvious.² The Examiner is wrong as a matter of law as obviousness cannot be predicted on what is unknown. *In re Newell*, 891 F.2d 399, 401 (Fed. Cir. 1989). “It is well established that in deciding that a novel combination would have been obvious, there must be supporting teaching in the prior art. ‘That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown.’” *In re Newell*, 891 F.2d 399, 901 (Fed. Cir. 1989) (citing *In re Spormann*, 363 F.2d 444, 448, 53 C.C.P.A. 1375, 1380, 150 U.S.P.Q. 449, 452 (1966)).

In the present case, there is, and can be, no motivation to combine Karpe *et al.* with Beeley *et al.* and Beers *et al.* because the inherent properties that are alleged by the Examiner, even if they were true, cannot be used since that which is inherent cannot be combined. *See Id.* at 901. *This should end the enquiry and the case be returned to the Examiner with instructions to withdraw the rejection.*

The Examiner Failed to Establish a Basis in Fact or Technical Reasoning for the Alleged Inherent Teaching of Beeley *et al.*

The Examiner appears to be arguing that Beeley *et al.* teaches lowering plasma lipids and that since triglycerides are a component of plasma lipids, Beeley *et al.* inherently teaches lowering triglycerides. This position is in error because the Applicant has provided evidence that

² See section titled “The Examiner Failed to Establish a Basis in Fact or Technical Reasoning for the Alleged Inherent Teaching of Beeley *et al.*”

such a correlation is not inevitable and in at least one case the opposite was found.³ Indeed, the Examiner has acknowledged that this is correct.⁴

Moreover, the Examiner has failed to provide a basis in fact or technical reasoning to establish the inherent characteristic relied on beyond merely asserting that Beeley *et al.* mentioned you could treat certain diseases that the Examiner associates with high triglycerides by lowering the plasma lipids with exendin.

To establish inherency “the Office must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). To be found inherent in an anticipating reference, an unstated element must exist as a matter of scientific fact and flow naturally from the elements expressly disclosed in the prior art reference. *Hughes Aircraft Co. v. U.S.*, 8 USPQ2d 1580, 1583 (Ct. Cl. 1988). Compare *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999); *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347 (Fed. Cir. 1999); *Abbott Laboratories v. Geneva Pharmaceuticals, Inc.*, 182 F.3d 1315 (Fed. Cir. 1999). The Examiner’s premise that Beeley *et al.*’s passing mention that you could treat certain diseases associated by the Examiner with high triglycerides by lowering plasma lipids with exendin is sufficient to establish a basis in fact or technical reasoning is in error.

The Examiner Ignores Identifying a Subject Having Elevated Postprandial Triglycerides to Administer an Exendin or Exendin Agonist.

As stated above, claim 1 recites a “method for lowering triglycerides in a subject in need thereof ... identifying a subject having elevated postprandial triglyceride levels.” As acknowledged by the Examiner, Beeley *et al.* does not discuss the use of exendins in the reduction of triglycerides (triglycerides are a subset of total plasma lipids, which include, *e.g.*, LDL, HDL, VLDL, and cholesterol). In an attempt to overcome this, the Examiner points to

³ Response under 37 C.F.R. § 1.116, filed June 15, 2006, page 3.

⁴ Advisory Action Before the Filing of an Appeal Brief, mailed July 26, 2006, continuation sheet 1.

Beers *et al.* for alleged support and states that Beers *et al.* points out that "triglyceride is one of two *major* types of plasma lipids." Final Action at page 3. However, like Beeley *et al.*, Beers *et al.* does not discuss the use of exendins in the reduction of triglycerides.

Moreover, the discussions of the lowering of plasma lipids in Beeley *et al.* are in the context of a reduction in food intake. As such, whatever else Beeley *et al.* does disclose, the reference does not teach or suggest the identification of a subject having elevated postprandial triglyceride levels and the ability of exendins to specifically lower triglycerides. The Examiner has also acknowledged, "Karpe does not teach a method for lowering triglyceride levels with an exendin." Office Action mailed November 17, 2004, at page 4. Accordingly, Karpe *et al.* does not remedy the deficiencies of Beeley *et al.*, and Beers *et al.* Even in combination,⁵ the recited references fail to describe or suggest identifying a subject having elevated postprandial triglyceride levels and administering a therapeutically effective amount of exendin.

CONCLUSION

In light of the above, Applicants request that the 35 U.S.C. § 103(a) rejections be withdrawn and the claims be allowed.⁶

Respectfully submitted,



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Date: August 15, 2006

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⁵ See section titled "The Examiner Erred in Combining an Alleged Inherent Teaching in a Reference to Render an Obviousness Rejection."

⁶ Nothing in this paper should be read to suggest that the arguments presented are the only arguments available to the Applicant or that certain claims are not separately patentable.